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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/997,850	11/29/2001	Brian P. Brockway	349.033US3	6258

7590 06/24/2003

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EXAMINER
NASSER, ROBERT L

ART UNIT	PAPER NUMBER
3736	

DATE MAILED: 06/24/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.	Applicant(s)
09/997,850	Brockway et al
Examiner	**Art Unit**
Robert Nasser	3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 57-90 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 57-90 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 2
4) ☐ Interview Summary (PTO-413) Paper No(s). _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 57-90 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-39 of US Patent 6033366 and claims 1-124 of U.S. Patent No. 6,379,308. Although the conflicting claims are not identical, they are not patentably distinct from each other because the current claims are broader versions of the patented claims, and, as such, are covered by the patented claims.

Claims 70, 71, 86, and 88 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled

in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. These claims recite that the catheter length is short enough to avoid significant head pressure artifact and provide sufficient dynamic response. They also recite that the length is long enough to accommodate surgical limitations and tolerance concerns. It is unclear what lengths are required for this to happen. Applicant has disclosed its desired range, but not at what lengths the artifacts become significant etc. In addition it is unclear what level of artifact is "significant" or what response is "sufficient." Clarification is required.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 69-72 are rejected under 35 U.S.C. 102(b) as being anticipated by Pohndorf et al. Pohndorf shows a catheter 16 filled with a pressure transmitting fluid that is implanted in the body to sense blood pressure variations, a transducer 26 in communication with the pressure transmitting medium and coupled to a wire 11 or 13, which are carried back to a pacer housing via a catheter 12. Element 16 has a length of one inch which is in the range disclosed to avoid significant head pressure artifact and to accommodate tolerance concerns.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 64 and 66-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brockway et al in view of Iwata et al. Brockway et al shows all of the claimed features, except that it uses a gel/fluid combination rather than a single gel. Iwata et al uses a single pressure transmitting medium to fill the entire catheter. From this teaching, it would have been obvious to modify Brockway et al to use only a gel, to simplify the overall design.

Claims 73,74, 76, 78-81, 83, and 85-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pohndorf et al in view of Brockway et al. With regard to claims 73 and 74, Brockway teaches an alternative pressure transmitting medium comprised of a gel and a fluid combination. Hence, it would have been obvious to modify Pohndorf et al to use this medium, as it is merely the substitution of one known medium for another. With regard to claim 76, Pohndorf et al uses a single medium, either a fluid or silicon rubber to entirely fill the catheter. Brockway et al teaches that a gel is also a known pressure transmitting medium. Hence, it would have been obvious to modify Pohndorf et al to use this medium, as it is merely the substitution of one known medium for another. Claims 81, 83, and 85-90 are rejected for the reasons given above.

Claims 78-80 and 89-90 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pohndorf et al in view of Brockway et al as applied to claims 73, 74, 76, 81, 83, and 85-88,

further in view of Mills et al. With regard to claims 78-80, Pohndorf is connected to a pace maker, which inherently has a telemetry system to send pacer information outside the body. However, it is unclear whether the pressure signal is sent out of the body, or merely used to adjust the pacer functions. However, Mills et al teaches that it is desirable to send a blood pressure signal out of the body, to keep the physician informed as the patient's status. Hence, it would have been obvious to transmit the pressure signal outside of the body, so the physician can accurately monitor the patient.

Claims 57-63 would be allowable if the double patenting rejection were overcome.

Claims 65, 75, 77, 82, and 84 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and if the double patenting rejection were overcome.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hastings uses air and a ferro-fluid as a pressure transmitting medium.

Kanai shows a pressure transmitting catheter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert L. Nasser Jr. whose telephone number is (703) 308-3251. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 8:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg, can be reached on (703) 308-3130. The fax phone number for this Group is (703) 308-0758.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [**max.hindenburg@uspto.gov**].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0858.

RLN
June 16, 2003

ROBERT L. NASSER
PRIMARY EXAMINER